

REMARKS

Upon entry of the present amendment, claims 1-9, 11-14, 16 and 18-25 remain pending in the application, and of these, claims 1, 9, 18, 19 and 25 are independent.

The above-identified Office Action has been reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment is submitted. It is contended that by the present amendment, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

35 U.S.C. 185 Issues

In the above-identified Office Action, the Examiner rejected claims 1-9, 11-14, 16 and 18-25 as unpatentable under 35 U.S.C. 185. The Examiner indicated that since a foreign application was filed in Japan on July 24, 2000 for the instant invention before the U.S. filing date, that such previous foreign filing barred issuance of a patent on the present U.S. application.

In response to the Examiner's concerns about 35 U.S.C. 185, applicant respectfully points out that this statutory section references the license prescribed in section 184 of this title (i.e. 35 U.S.C. 184). Applicant further points out that 35 U.S.C. 184, by its own terms, only applies to invention made in the United States. Applicant reproduces the first sentence of 35 U.S.C. 184 hereinbelow, with emphasis added by the applicant.

Sec. 184. - Filing of application in foreign country

Except when authorized by a license obtained from the Commissioner of Patents a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country.

Applicant respectfully submits that neither of sections 184 or 185 is applicable to a situation in which an invention is not made in the United States.

THE INVENTION OF THE PRESENT APPLICATION WAS MADE IN JAPAN

Applicant encloses herewith a signed affidavit of Mr. Akihiro Suzuki. Mr. Suzuki is the Chief Executive Officer of Kabushiki Kaisha AKI International, the assignee of the present

invention. The enclosed affidavit establishes that Mr. Suzuki has personal knowledge of the circumstances surrounding the invention disclosed in the present application, and that the invention was not made in the United States, but instead, was made in Japan.

Applicant respectfully submits that the enclosed affidavit overcomes the rejection of applicant's claims under 35 U.S.C. 185, and requests reconsideration and withdrawal of such rejection.

35 U.S.C. 103 Issues

Also in the above-identified Office Action, the Examiner rejected claim 25 under 35 U.S.C. 103 as unpatentable over Dykema et al. in view of Andrew et al.

Applicant traverses the Examiner's rejection of claim 25, and requests reconsideration and withdrawal thereof.

The Standard for Obviousness under Federal Circuit Law

Applicant respectfully wishes to call the Examiner's attention to some relevant cases of the U.S. Court of Appeals for the Federal Circuit (CAFC). The CAFC was established in 1982 to bring national standards, and a certain level of conformity and continuity to Federal patent case law. Decisions of the Federal Circuit are relevant and helpful in giving guidance to private patent practitioners, as well as to the personnel of the U.S. Patent and Trademark Office.

The U.S. Court of Appeals for the Federal Circuit has said that a reference must be viewed in its entirety, *Gore v. Garlock*, 220 U.S.P.Q. 303 (CAFC 1983) and that it is impermissible to use the claims as a frame, and the references as a mosaic, to pick and choose selected pieces, out of context, to reconstruct the invention, *Northern Telecom v. Datapoint*, 908 F.2d 931 (CAFC 1990).

The U.S. Court of Appeals for the Federal Circuit has also said that that in order to combine references, the Examiner must show some motivation, suggestion, or teaching of the desirability of making the combination, *In re Dembiczak*, 50 USPQ 2d 1614, 1617 (CAFC 1999); and that the use of hindsight, in evaluating patentability, is improper, *In re Werner Kotzab*, 55 U.S.P.Q. 2d 1313 (CAFC 2000); *Gore v. Garlock*, *supra*.

Specifically, in *Kotzab*, *supra*, the CAFC stated:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See

Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.*

Most, if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant (citations omitted).

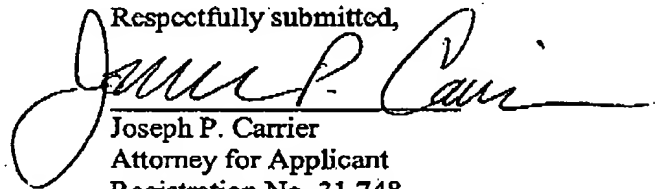
Applicant respectfully suggests that the Examiner appears to be evaluating applicant's invention using improper hindsight, picking and choosing selected portions of the references and combining those selected portions to reconstruct a mosaic of applicant's invention. Applicant respectfully suggests that such an approach is not consistent with the standards set out in the above-quoted cases of the CAFC.

Applicant respectfully submits that each of the claims distinguishes over all art of record, considered either individually or in any reasonable combination thereof.

Applicant therefore requests reconsideration and withdrawal of the Examiner's rejection of the claims, and allowance of the present application.

Favorable reconsideration is respectfully requested.

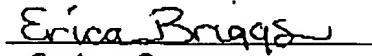
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to Art Unit 3618 of the U.S. Patent and Trademark Office at the number (703) 872-9306, on July 6, 2004.

Dated: July 6, 2004


Erica Briggs